

**REMARKS**

Claims 1-14, 17-28, and 35-42 are pending in this application. By this Reply, Applicant has amended claims 3, 12, 25, and 35. The originally filed disclosure fully supports these amendments. For example, Fig. 9 shows an intake valve in an intermediate position and paragraph 42 of the specification describes holding the valve element opened for a predetermined amount of time. No new matter has been added.

Claims 3-14, 17-20, and 22-40 were rejected under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 5,692,469 to Rammer ("Rammer"). Claims 1, 2, 21, 41, and 42 were rejected under 35 U.S.C. § 103(a) based on Rammer in view of United States Patent No. 5,996,550 to Israel ("Israel"). These rejections should be withdrawn for at least the reasons set forth in the following discussion.

**Rejections Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 3-14, 17-20, and 22-40 based on Rammer and the rejection of claims 1, 2, 21, 41, and 42 based on Rammer in view of Israel.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these

requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

In rejecting claims 3-14, 17-20, and 22-40 based on Rammer and claims 1, 2, 21, 41, and 42 based on Rammer in view of Israel, the Examiner has failed to establish a *prima facie* case of obviousness because neither Rammer, nor the combination of Rammer and Israel teaches each and every element recited in the claims. For example, Rammer does not teach that the source of pressurized fluid is “insufficient to move the valve element toward the open position,” as recited in amended independent claim 3 and in independent claims 1 and 21. The Office Action acknowledges that this feature is not taught by Rammer. (Office Action at 4.) However, the Office Action alleges that Israel teaches the use of low pressure fluid which would be insufficient to move the valve into the open position. (Office Action at 5.) Israel does not contain such a teaching. Instead, Israel specifically teaches that during compression, the motion transferred by the hydraulically transferring means is **greater** than the motion transferred by the mechanically transferring means. (Israel, col 12., line 65 - col. 13, line 3.) Because Israel teaches the use of fluid which may overcome the mechanical actuation means, having the source of pressurized fluid be “insufficient to move the valve element toward the open position” would not be obvious to Israel. Claims 1, 3, and 21 are therefore allowable for at least the reasons discussed above.

In regards to independent claims 9, 12, 22, 25, and 35 the Examiner has failed to establish a *prima facie* case of obviousness because neither Rammer, nor the combination of Rammer and Israel, teaches each and every element recited in the claims. For example independent claim 9 contains the limitation that “the fluidically

driven actuator adapted to prevent the intake valve from moving to the second position for a predetermined period of time,” and claims 12, 22, 25, and 35 contain limitations similar in scope. As described in the specification, the invention, as claimed, prevents the intake valve from moving to the second position for a **predetermined** stroke length. (Specification, paragraph 42.) However, Rammer discloses that the length of time that valve will be held in the intermediate position depends on the pressure. (Rammer, col. 5, lines 18-24.) This does not meet the limitation of being for a “predetermined period of time.” See *Planet Bingo, LLC v. GameTech Int’l, Inc.*, 472 F.3d 1338, 1342-43 (Fed. Cir. 2006) (claim term “establishing a *predetermined* combination as a winning combination for the progressive jackpot pool” requires that the winning combination be established before the game.). Israel does not disclose maintaining any valve in an intermediate position, and therefore also does not teach that “the fluidically driven actuator adapted to prevent the intake valve from moving to the second position for a predetermined period of time.” Claims 9, 12, 22, 25, and 35 are therefore allowable for at least the reasons discussed above.

Dependent claims 2, 4-8, 10, 11, 13, 14, 17-20, 23, 24, 26-28, 36-42 depend from one of claims 1, 3, 9, 12, 21, 22, 25, or 35 and therefore, are allowable for at least the reasons discussed above and in view of their additional recitations of novel subject matter.

### **Conclusion**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-14, 17-28, and 35-42 in condition for allowance. Applicants submit that the proposed amendments do not raise new issues

or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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